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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/342,680	06/29/1999	ERIC C. ANDERSON	1418CIP/P160	6924

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EXAMINER
HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 05/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/342,680	ANDERSON ET AL.	
	Examiner	Art Unit	
	Cong-Lac Huynh	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 February 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. This action is responsive to communications: appeal brief filed on 3/25/02 to the application filed on 06/29/99.

2. Claims 1-20 are pending in the case. Claims 1, 8, 13 are independent claims.

Claim Rejections – 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 8, 11-13 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Xu (US Pat No. 5,848,42012/8/98, filed 6/14/96) in view of Narayen et al. (US Pat No. 6,035,323, 3/7/00, filed 10/24/97).

Regarding independent claim 1, Xu discloses:

(a) connection between the digital camera and the computer without the need for loading camera-specific communication software (figure 1; col 3, lines 55-67 to col 4, lines 1-3, connecting the camera to the host computer via serial port or serial port equipped camera; col 4, lines 30-45)

(c) mounting the image capture device as a disk on the host computer without the need for loading camera-specific communication software (abstract; col 2, lines 15-35; col 3, lines 55-65; col 4, lines 32-39, mounting the camera as a disk drive accessible by the computer system by a software program)

It is clear that step (a) establishing communication between the image capture device and the host computer, and step (c) mounting the image capture device as a disk on the host computer are performed without having to load device-specific software onto the host computer, since the connection is made via the serial port and the software program for said mounting in Xu are not a device-specific software or a camera-specific communication software.

Xu does not disclose generating the image files stored in the digital camera into HTML format and opening these files in the computer system without loading any camera-specific communication software onto the host computer.

Narayen discloses:

(b) automatically generating an Internet page description file in the image capture device that references the images stored therein without the need for loading a camera-

specific communication software onto the host computer (figure 1, steps 10, 12; figure 5, steps 225, 229)

(d) opening the Internet description file in a web browser on the host computer (figure 5, step 231, 233, images in HTML format are generated and sent to users for viewing), wherein the image stored in the image capture device are displayed on the host computer through the web browser without the need for loading camera-specific communication software onto the host computer (col 5, lines 50-67; col 6, lines 28-45).

It is noted that there is a Web authoring software in Narayen, but that software is not a device-specific software or a camera-specific communication software.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Xu into Narayen to obtain a connection between a PC and a digital camera, an access to the digital camera on the operation system of the computer, and a HTML file containing images from the digital camera ready to use for users without having to load a camera-specific communication software onto the host computer.

Claims 8,13 are for the system and the computer-readable medium of method claim 1, and therefore are rejected under the same rationale.

Regarding claims 11-12, it was obvious that the Internet page is a HTML page and images are transferred from a digital camera to the host computer and the Internet as disclosed above.

6. Claims 2-5, 9-10, 14-18 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Xu and Narayen as applied to claim 1 above, and further in view of Cohen et al. (US Pat No. 5,805,829, 9/8/98, filed 10/1/96).

Regarding claim 2, which is dependent on claim 1, Xu and Narayen do not disclose the providing of Java files with the Internet page description files in the image capture device.

Cohen discloses that a web page can include programs of Java files called applets for execution live images of the web page content (col 1, lines 20-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Cohen into Narayen and Xu for providing Java files along with the internet page file for executing images captured from the image capture device connected to the host computer.

Regarding claim 3, which is dependent on claim 2, it was well known that compressing is applied for easy transferring image files, which can be Java files as in Cohen, with a large amount of data. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Cohen to include decompressing since it was well known in the art that a compressed file should be decompressed after being transferred for displaying on the web browser.

Regarding claim 4, which is dependent on claim 3, Narayen discloses the generating the Internet page description when the communication with the host computer is indicated (figures 1, 4, 8).

Regarding claim 5, which is dependent on claim 4, Narayen discloses the storing of the images displayed in the web browser on the host computer by copying the compressed images files from the image capture device directly to the host computer (col 6, lines 31-45).

Claims 9-10, 14-18 are for the system and the computer-readable medium of method claims 2-5 and therefore are rejected under the same rationale.

7. Claims 6-7, 19-20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Xu and Narayen as applied to claim 5 above, and further in view of Wang et al. (US Pat No. 6,058,428, 2/5/00, filed 12/5/97).

Regarding claim 6, which is dependent on claim 5, Xu and Narayen do not disclose the copying of image files, which is determined not being previously copied, to the host computer.

Wang discloses:

- determining if any of the compressed image files have previously been copied to the host computer (col 5, lines 59-67; col 6, lines 42-50)

- copying only the compressed image files to the host computer that have not been previously copied (col 5, lines 59-67; col 6, lines 42-50)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Wang into Narayen to enhance that feature to Xu and Narayen to avoid the duplicate files when copying.

Regarding claim 7, which is dependent on claim 6, Narayen discloses:

- uploading the image files and the internet page description file to the host computer (figures 4, 5, 9)
- opening the internet page description file in the web browser on the host computer to display the images stored in the host computer (figures 4, 5, 9)

Though Narayen does not explicitly disclose the computer on which the web page displayed is the host computer. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have recognized that said computer is a host computer as claimed since it is connected to the digital camera and is where to display images from the digital camera.

Claims 19-20 are for the computer-readable medium of method claims 6-7, and therefore are rejected under the same rationale.

Response to Arguments

8. Applicant's arguments filed 2/25/02 have been fully considered but they are not persuasive.

Applicants argue that Xu and Narayen fail to teach or suggest mounting the image capture device as a disk on the host computer without the need for loading communication software onto the host computer (appeal brief, page 7). Applicants further emphasize that each step in claim 1 from (a) to (d), including the mounting step, must be performed without having to load device-specific software onto the host computer (appeal brief, page 9) as disclosed in the specification of the invention.

Examiner disagrees.

It appears that applicants meant Xu and Narayen fail to teach steps (a) to (d) without having to load device-specific software onto the host computer. Therefore, applicants' arguments seem to be contradicted since the device-specific software is different from the communication software.

Xu discloses mounting the image capture device as a disk on the host computer without having to load device-specific software onto the host computer. Specifically, Xu discloses the serial port, the serial port equipped camera for connecting the camera to the host computer for permitting the stored images to be directly accessed by the computer system (col 3, lines 55 to col 4, lines 1-3). Xu also discloses a software program for mounting the camera as a disk drive in the host computer (col 4, lines 32-

39). It is clear that step (a) establishing communication between the image capture device and the host computer, and step (c) mounting the image capture device as a disk on the host computer are performed without having to load device-specific software onto the host computer, since the connection is made via the serial port and the software program for said mounting in Xu are not a device-specific software or a camera-specific communication software.

Narayen discloses step (b) generating an Internet page description file in the image capture device that references the images stored therein (figure 1, steps 10, 12; figure 5, steps 225, 229), and step (d) opening the Internet description file in a web browser on the host computer (figure 5, steps 231, 233) wherein the images stored in the image capture device are displayed on the host computer without the need for loading camera-specific communication software onto the host computer (col 5, lines 50-67; col 6, lines 28-45). It is noted that there is a Web authoring software in Narayen, but that software is not a device-specific software or a camera-specific communication software.

In short, Xu and Narayen disclose four steps (a) to (d) without having to load a camera-specific communication software onto the host computer.

Applicants also argue that Xu in view of Narayen fails to teach or suggest automatically generating an internet description file or HTML file in an image capture device or a digital camera that references the images stored therein. Applicants point out that the system claim 8 states that "the digital camera including means for generating an

Internet page description file..." That means said generating happens within the camera whereas generating a description file in Narayen happens in the computer.

Examiner disagrees.

The invention as a whole is not consistent since in claims 1 and 13, the step generating can happen somewhere, not within the digital camera, whereas claim 8 does. Specifically, claim 1 states that "automatically generating an Internet page description file in the image capture device that references the images stored therein." Claim 13 states that "automatically generating an HTML file that references the images stored in the digital camera."

More specific that generating could be on a computer outside of the camera

It is clear that said generating an HTML file that, as claimed, references the images stored in the digital camera. It does not state that generating should happen in the digital camera.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is (703)-305-0432. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. The fax number to this Art Unit is (703) 308-5403.

11. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-5403 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA. Sixth Floor (Receptionist).

clh

5/17/02

STEPHEN S. HONG
PRIMARY EXAMINER